



11 JAN 2005

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In re Application of: :  
Carlsson et al. :  
Application No.: 09/868,526 : DECISION  
PCT No.: PCT/SE99/02311 :  
Int. Filing Date: 10 December 1999 : ON  
Priority Date: 22 December 1998 :  
Atty. Docket No.: CU-2571 : PETITION  
For: Tool Handle :  
:

This is in response to the petition filed on 29 and 30 November 2004.

### DISCUSSION

#### *Petition Under 37 CFR 1.137(b)*

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the required reply (as required by the decision mailed on 15 July 2003 and described below) has been submitted.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

#### *Petition Under 37 CFR 1.47(a)*

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own

behalf and on behalf of the non-signing joint inventor. Petitioner has already satisfied requirements (1), (2) and (3).

Regarding requirement (4), the decision mailed on 15 July 2003 indicated that the declaration filed on 15 April 2002 was not acceptable because

petitioner states that "In the declaration filed April 15, 2002, it is absolutely clear that Stephan Carlsson signed only on his behalf and that the Assignee has signed on behalf of Jack Chalas." Petitioner's attention is drawn to the first sentence of 37 CFR 1.47(a), which states that "If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor." Thus, the regulation permits relief where the application is made by the other inventor on behalf of himself and the nonsigning inventor, but no provision for relief is made where the "other inventor" has made application on his own behalf and an assignee seeks to make application on behalf of the non-signing joint inventor (but *see* 37 CFR 1.47(b)). As petitioner has unambiguously stated that Mr. Carlsson did not make application on behalf of himself and Mr. Chalas, it would not be appropriate to accept the declaration filed on 15 April 2002.

The instant renewed petition is accompanied by a declaration document which is signed on behalf of both non-signing inventor Jack Chalas and deceased inventor Stefan Carlsson, but it has not been established that the person signing the declaration is either the legal representative or (if appropriate) the sole heir of Stefan Carlsson (as described in the following treatment of the petition under 37 CFR 1.42). As such, it would not be appropriate to grant the petition under 37 CFR 1.47(a) at this time.

#### *Petition Under 37 CFR 1.42*

Review of the declaration of the inventors filed on 30 November 2004 reveals that it indicates that joint inventor Stefan Carlsson is deceased. 37 CFR 1.42 provides in part that

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the

legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Further examination of the declaration reveals that it includes the citizenship and residence of the deceased inventor and of Irene Elvingsson-Carlsson, who has signed on behalf of Stefan Carlsson as "legal representative" and also of behalf of non-signing inventor Jack Chalas. However, the post office address of neither Stefan Carlsson nor Irene Elvingsson-Carlsson has been provided. Moreover, it is not clear whether Irene Elvingsson-Carlsson is in fact signing as "legal representative" because the accompanying "Proof of Authority..." clearly states that "they are all the heirs and that the estate did not require the appointment of an administrator or that they have the authority corresponding to that of an administrator or heir." The accompanying translation of the "Estate Inventory" indicates that Irene Elvingsson-Carlsson is the "beneficiary" and one heir of Stefan Carlsson, but she is not clearly named as a legal representative (indeed, the form names Sture Kallvant HB" as "Administrator"). In addition, she apparently is not the sole heir, since Adam Carlsson and Simon Carlsson are also indicated to be heirs. Since neither a legal representative has signed nor, if no legal representative has been appointed and the applicable law does not require the appointment of a legal representative, all of the heirs have signed, it would not be appropriate to grant the requested relief at this time.

### CONCLUSION

The petition is under 37 CFR 1.137(b) is **GRANTED**.

The petition is under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

The petition is under 37 CFR 1.42 is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence regarding this matter should be addressed to the Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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